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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,278	11/13/2000	Michael Reggelin	147/49227	2959
23911	7590	05/03/2004	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			HUANG, EVELYN MEI	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/700,278	<b>Applicant(s)</b> REGGELIN ET AL.	
	<b>Examiner</b> Evelyn Huang	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17,18,20-22,24,25,27-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,18,20-22,24,25,27-29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-24-2003 has been entered.
2. Claims 17, 18, 20-22, 24, 25, 27-29, 31-33 are pending. Claims 1-16 have been canceled according to the preliminary amendment filed on 11-13-2000. Claims 26, 30 have been canceled according to the amendment filed on 5-14-2002. Claims 19 and 23 have been canceled according to the amendment filed on 10-11-2002.

### ***Claim Rejections - 35 USC § 102***

3. The 35 U.S.C. 102(a) rejection for claim 27 over Bolte (PTO-1449) is withdrawn in view of the amendment excluding the compound of Bolte.

### ***Claim Rejections - 35 USC § 103***

4. The 35 U.S.C. 103(a) rejection for Claims 27-28 over Bolte (PTO-1449) in view of Greene is withdrawn in view of the amendment excluding the compound of Bolte. Lacking is the motivation to modify Bolte's compound to arrive at the instant invention.

### ***Claim Rejections - 35 USC § 112(2)***

5. The rejection under 35 U.S.C. 112, second paragraph set forth in paragraph 6(a), (c), (d) is withdrawn in view of the amendment obviating the rejection.

Art Unit: 1625

The rejection is maintained for claim 21, wherein the term 'comprises' in 'the base reagent comprises' is open ended and does not exclude additional unrecited elements, and is therefore indefinite. See MPEP 211.03. Furthermore, there is no description in the specification that the base reagent is a mixture of piperidine and other basic ingredients, as applicant maintains to be the intention of the claim. On page 16, line 8, of the specification, it is stated that 'piperidine is preferred as a base for the cleavage thereof', not piperidine in combination with other basic ingredients as asserted. Replacing 'comprises' with – is – is recommended.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17,18, 21, 22, 24, 25, 27-29, 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 17, the compound of formula Ia', which was presented in the preliminary amendment, has no antecedent basis in the specification, wherein only compound of formula I and compound of formula of Ia are described. What is the meaning of (2a) in formula Ia' ? A definition is not found in the specification.

b. Claim 18, a compound of formula Ib has no antecedent basis in the base claim 17 wherein formula Ib has been deleted.

c. Claim 24, a compound of formula Ib has no antecedent basis in the base claim 17 wherein formula Ib has been deleted.

d. Claim 27, it is recommended that the negative proviso be rewritten in a positive manner, i.e. when n=0, R801 is hydrogen....., lower alkyl or lower-alkoxy lower alkyl, which has support in the specification.

e. Claim 31, R3-R7, R10, R11, R101, R801, R901 should have the meanings given in claim 27 instead of the recited claim 17.

The rejection is applicable to claims dependent on the above claims.

Art Unit: 1625

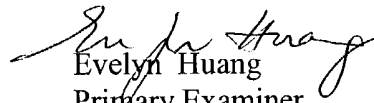
***Allowable Subject Matter***

7. The subject matter of claims 17, 18, 20-22, 24, 25, 27-29, 31-33 would be allowable if the above 112 second paragraph rejection were overcome.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn Huang  
Primary Examiner  
Art Unit 1625